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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Theodore D. Wugofski
Serial No.: 09/002,600
Filed: January 5, 1998
Title: SYSTEM AND METHOD FOR REMINDING USERS OF UPCOMING
SCHEDULED RECORDINGS

Examiner: Christopher Onuaku

Group Art Unit: 2615

Docket: 450.224US1

APPELLANT'S REPLY BRIEF

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Commissioner for Patents
Washington, D.C. 20231

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In response to the September 9, 2002 Examiner's Answer in the appeal of the above-identified patent application, appellant respectfully submits and requests entry of this Reply Brief. Appellant presents the brief in triplicate, and authorizes the Examiner to charge any necessary fees to Deposit Account No. 19-0743.

In regard to claims 4, 5, 12, which require an act of outputting the recording-reminder signal to a network communications device, the Examiner's Answer (at page 22) proposes a new motivation for his combinations involving Hoff. In the Final Action, the Examiner had proposed “[i]t would have been obvious to one of ordinary skill to further modify Young ... as taught by Hoff, which would increase the capability of Young thereby making Young more commercially attractive.” Appellant challenged the objectiveness and evidentiary basis for this motivation (at pages 14 and 15 of its Appeal Brief), and in response to that challenge, the Examiner's Answer offers the new motivation, specifically stating:

The superior results of transmitting pager messages through a communication network device are all that would be needed to motivate the artisan to apply the same principle [in] Hoff of transmitting pager messages through the communication network to a pager (a recording system) in transmitting recording reminder messages through a communication network to another recording system, for example.

In response, appellant now submits respectfully that the new motivation, like its predecessor, is also inadequate. Specifically, it's based on an impermissible degree of hindsight, since no objective evidence has been offered to substantiate that the art recognized any superiority of network communications for communicating recording-reminder messages, or

conversely any inferiority or deficiency in the reminder-communication modes reported in Young and Ellis. Indeed, the only nexus between network communications and recording-reminder messages is in the teachings of the present application. Thus, given the obvious omission of any objective evidence, one must conclude that the newly fashioned motivation of "superior communications" is born not from the art, but from an impermissible degree of hindsight analysis.

The law is that "the Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness." *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988) (Copy provided with Appeal Brief). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* In *In re Sang-Su Lee*, 277 F.3d 1338; 61 USPQ2D (BNA) 1430 (Fed. Cir. 2002) (Copy provided with Appeal Brief), the Federal Circuit spoke again on combining and modifying references to support an obviousness inquiry, declaring that

"The factual inquiry whether to combine references ... must be based on objective evidence of record. ... Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." (Citations and internal quotations omitted.)

In view of this well-established law and the continued failure of the Examiner to show an objective basis in the art for combining Hoff with Young and/or Ellis, appellant respectfully urges the Board to overturn the §103 rejection of claims 4, 5, and 12.

Additionally, appellant submits that even if there were a showing of sufficient motivation for combining Hoff with Young and Ellis, the resulting combination would still not overcome the admitted failure of Young and Ellis to teach "outputting a [recording reminder] message to a network communication device associated with at least one user of the computerized system." Hoff reports use of a VCR to record incoming pager messages. See, for example, Hoff's abstract and Figure 1. There appears to be nothing in Hoff indicating that its VCR outputs any messages

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to a network or to a pager, and the Examiner has not cited anything in Hoff that suggests otherwise. In fact, the Hoff system appears only to provide network or pager communication to the VCR, not communications from the VCR to network devices . See, for example, Hoff's Fig. 1 which suggests not only that box 42 has only an output to VCR 53, but also that it includes no transmitter or output path to antenna 44.

Therefore, even if it were permissible to combine Hoff with Young and/or Ellis, the resulting combination would not overcome the admitted failures of Young and Ellis to teach the requisite act of "outputting a [recording reminder] message to a network communication device associated with at least one user of the computerized system."

Conclusion

In view of the inadequate motivation for combination and/or the failure of the proposed combination to meet all the terms of the claims 4,5, and 12, appellant respectfully renews its request that the Board overturn the §103 rejection of these claims. Appellant also renews its request, based on the reasons highlighted in its Appeal Brief, that the rejection of the other pending claims also be overturned.

Respectfully submitted,

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We are transmitting herewith the following attached items (as indicated with an "X"):

A return postcard.
 Appellant's Reply Brief (3 Pages).

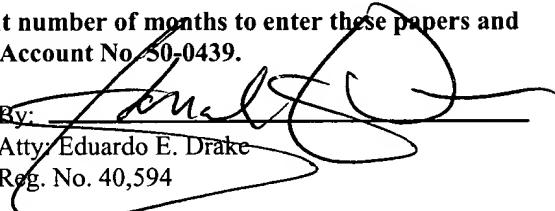
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Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional required fees or credit overpayment to Deposit Account No. 50-0439.

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